UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,336	12/14/1998	ERLAND WITTKOTTER	HPB-7	2766

826 7590 02/04/2005		EXAMINER
ALSTON & BIRD LLP		BACKER, FIRMIN
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ART UNIT	PAPER NUMBER
3621	

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DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 January 2005</u> .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1 and 3-18</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1 and 3-18</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on January 3rd, 2005 has been entered.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1, 3-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter (U.S.

PG Pub No. 2004/0133793).

4.   As per claims 1 and 9, Ginter et al teach an apparatus for protecting electronically

published documents with a local computer system which can be connected locally by way of the

internet to an external data source and which is adapted to call up, execute, or output the

electronically published documents, wherein the local computer system comprises local data

storage means which is adapted for the storage of data of the electronically published document

in a form which is not usable for a user, wherein the local computer system further comprises

means capable of receiving and processing additional protection data provided by the external

data source by way of the internet following establishment of authenticated contact or at least

temporary authenticated contact between the local computer system and the external data source

session, as well as a linking means which is adapted to link a storage content of the local data

storage means with the additional protection data and to produce the electronically published

document therefrom in a form usable, meaningful or suitable for sensory perception by the user,

and wherein the local computer system comprises output means selected in accordance with the

type of the document to be electronically published, adapted to call up, execute or output the

document in the form usable, meaningful or suitable for sensory perception by the user, wherein

the data storage means is adapted to store the electronically published document in a non-

reconstructed, in particular a non-linear form, wherein the non-reconstructed document can be

converted into a reconstructed linear document, which is usable by the user, by the action of the

linking means, utilizing the additional protection data, characterized in that the local computer

system is desired to ensure such that a local storage of the produced document in the form

usable, meaningful or suitable for sensory perception is not possible, and readability or usability

of the produced document is dependent, on authenticated contact or at least one temporary

authenticated contact between the local computer system and the external data source via the

internet prior to receipt of the additional protection data by the local computer system (*see*

paragraphs 0025, 0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229).

5.   As per claim 3, Ginter et al teach an apparatus characterized in that the linking means is

adapted such that structural elements of an electronically published document are modified by

operational instructions derived from the additional protection data in order to effect the

conversion to the reconstructed document (*see paragraphs 0025, 0119, 0173, 0226, 1118, 1197,*

1863, 1996, 2229)..

6.   As per claim 4, Ginter et al teach an apparatus characterized in that the local data storage

means is a magnetic or optical mass store in which the non-reconstructed data of the

electronically published document are stored in a plurality of storage locations which are not

interrelated, and wherein the additional protection data denote an interconnection or a sequence

of the storage locations (*see paragraphs 0025, 0119, 0173, 0226, 1118, 1197, 1863, 1996,*

2229)..

7.   As per claim 5, Ginter et al teach an apparatus characterized in that the local data storage

means is a magnetic or optical mass store, wherein the non-reconstructed data of the

electronically published document which is stored therein have data gaps and the data gaps are

directly closed by the additional protection data, or wherein the additional protection data include

storage location identifications which refer to separate storage locations of the local data storage

means, in which data, suitable to filling up the data gaps, are stored in a manner corresponding to

the data gaps (*see paragraphs 0025, 0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229)..*

8.   As per claim 6, Ginter et al teach an apparatus characterized by an encoding means which is embodied by means of a first module of the external data source and a second module of the local computer system and which is adapted for the protected transmission of the additional protection data from the external data source to the local computer system (*see paragraphs 0025, 0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229*)..

9.   As per claim 7, Ginter et al teach an apparatus characterized by an identification or billing module which is adapted to identify a user of the local computer system and to acquire corresponding use or billing data (*see paragraphs 0025, 0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229*)..

10.   As per claim 8, Ginter et al teach an apparatus characterized by a control module where is provided in the local computer system and which is provided for dialogue and operational control of the data exchange with the external data source or an operating unit which is provided to detect user commands and to influence operation of the local computer system as a reaction to the user commands (*see paragraphs 0025, 0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229*)..

11.   As per claim 10, Ginter et al teach a method of deriving operational instructions from the additional protection data, modifying structural elements of an electronically published document with the operational instructions, thereby providing a re-constructed document in the form usable, meaningful or suitable for sensory perception by the buyer (*see paragraphs 0025, 0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229*)..

12.   As per claim 11, Ginter et al teach a method characterized in that storage of local

document data is effected in a sequence which, without linking to the additional protection data,

does not permit representation of the document data in the form usable, meaningful or suitable

for sensory perception (*see paragraphs 0025, 0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229)..*

13.   As per claim 12, Ginter et al teach a method characterized in that storage of the local

document data with gaps occurs in such a way that the gaps are filled up by linking to the

additional data (*see paragraphs 0025, 0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229)..*

14.   As per claim 13, Ginter et al teach a method characterized by identifying the user in the

external data source, and exchanging user or billing data in respect of the user as a reaction to

identification prior to reception of the additional protection data (*see paragraphs 0025, 0119,*

0173, 0226, 1118, 1197, 1863, 1996, 2229)..

15.   As per claim 14, Ginter et al teach a method characterized in that the step of receiving the

additional protection data includes encoding of the additional protection data by the external data

source, transmitting the encoded additional protection data by way of the internet, and decoding

the encoded additional protection data by the local computer system (*see paragraphs 0025,*

0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229)..

16.   As per claim 15, Ginter et al teach a method characterized by establishing a code

agreement between the external data source and the local computer system prior to the encoding

(*see paragraphs 0025, 0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229*).

17.   As per claim 16, Ginter et al teach a method characterized by successively calling up and

representing a plurality of document units, wherein a set of the additional protection data is

received for each of the document units (*see paragraphs 0025, 0119, 0173, 0226, 1118, 1197,

1863, 1996, 2229*)..

18.   As per claim 17, Ginter et al teach a method characterized in that the reception of the

additional protection data is dependent on a single or temporary access authorization established

by agreement between the local computer system and the external data (*see paragraphs 0025,

0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229*)..

19.   As per claim 18, Ginter et al teach a method a method characterized in that the data

which are usable by the user include a test, produced in a language, and having a plurality of

words, the words are provided in an arrangement which forms a meaning for the user, and at

least one of the words is arranged by the effect of the additional data at a position in the text

which permits clear identification and association of the text with the user (*see paragraphs 0025,

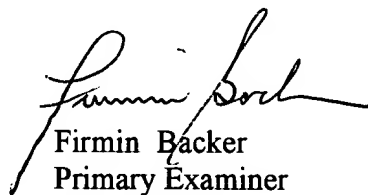0119, 0173, 0226, 1118, 1197, 1863, 1996, 2229*)..

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The

examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Firmin Backer
Primary Examiner
Art Unit 3621

February 3rd, 2005